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NO. 403 D009

REMARKS

Claims 1, 3-4, 7-12, 14-15, 18-29, 31, 32 and 34 remain pending in this application.

Claims 6, 17, 30, 33 have been canceled.

Response to Advisory Action of August 4, 2005:

Applicant has amended claims 1 and 7 to state that the turf engaging structure is in contact with the turf surface to precondition the turf surface prior to engagement by the main sweeper brush.

Claim Rejections

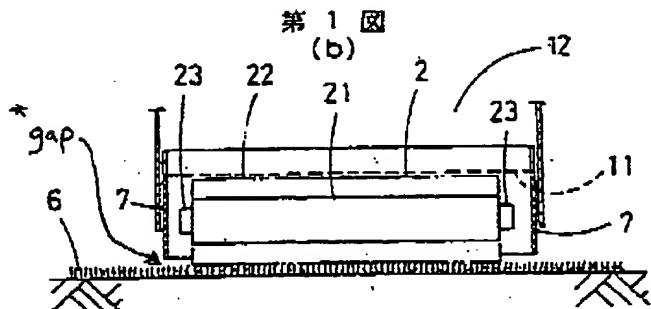
Claims 1, 6-7, 9, 12, 14, 17-18, 20, 23, 24, 26, 29, 30, 32-34 were rejected under 35 U.S.C. § 102(b) as being anticipated by JP40060005.

It is fundamental patent law that anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference.

Telemac Cellular Corp. v. Topp Telecom, Inc., 247 F.3d 1316, 1327, 58 U.S.P.Q.2d 1545, 1552 (Fed. Cir. 2001); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, anticipation under section 102 is only valid when a reference shows exactly what is claimed; where there are differences between the references disclosures and the claim, a rejection must be based on obviousness under Section 103. *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

It is respectfully submitted that JP40060005 does not anticipate the invention of the present claims. JP40060005 does not disclose a turf engaging structure for preconditioning the turf prior to engagement by the sweeper brush. It is submitted that the Examiner's contention that element (7) of JP40060005 is a "turf engaging structure" is in error. Referring particularly to Fig. 1(b) of JP40060005 (reproduced below), it appears that when the brush (2) is in its operational position, element (7) does not engage the turf surface, but is rather displaced some distance away from the turf surface.

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As illustrated in FIGS. 1(a) and (b), element (7) is purportedly a guard including a pair of side walls, a front wall, and a rear wall. As particularly shown in FIG. 1(b), the side walls and rear wall (and presumably the front wall) are displaced some distance away from the turf surface and therefore do not engage and precondition the turf surface when the brush (2) engages the turf surface.

Claims 1, 12, 29 and 32 have been amended to include the limitations of claims 6, 17, 30 and 33. As claims 1, 12, 29 and 32 have been amended to place the claims in better form for consideration on appeal, it is requested that these amendments be entered.

Claims 3, 4, and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over JP 40060005.

As discussed above, JP 40060005 fails to disclose or teach the invention as presently claimed. JP 40060005 fails to disclose or teach a turf engaging structure in contact with the turf surface and preconditioning the turf surface prior to an engagement by the main sweeper brush. Element (7) of JP 40060005 does not engage the turf surface, *see*, FIG. 1. (b).

The "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01; *see also, In re Mills*, 916 F.2d 680, 682, U.S.P.Q. 2d 1430, 1432 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." Id.

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NO. 403 Q011

Here, the Examiner has not provided any suggestion to modify JP 40060005 so that element (7) is provided in contact with the turf surface.

Claims 8, 10, 11, 19, 21, 22 25, 27, 28 and 31 were rejected under 35 U.S.C. § 103 as being unpatentable over JP 40060005 in view of U.S. Pat. No. 5,940,928 to Erko.

For the reasons set forth above, JP 40060005 fails to disclose or teach the invention as presently claimed. JP 40060005 fails to disclose or teach a turf engaging structure in contact with the turf surface and preconditioning the turf surface prior to an engagement by the main sweeper brush. Element (7) of JP 40060005 does not engage the turf surface, *see, FIG. 1. (b).*

Again, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

M.P.E.P. § 2143.01; *see also, In re Mills*, 916 F.2d 680, 682, U.S.P.Q. 2d 1430, 1432 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." Id.

Here, the Examiner has not provided any suggestion to modify JP 40060005 so that element (7) is provided in contact with the turf surface.

Reconsideration of these rejections is requested.

CONCLUSION

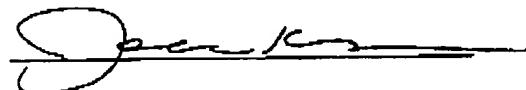
Applicant respectfully requests that the Examiner reconsider the pending rejections and enter the amendments to claims 1, 12, 29 and 32 in order to place the claims in better form for consideration on appeal.

Please direct any questions regarding this application to John Klos at (612) 321-2806.

Respectfully submitted,
Tennant Company, by its attorneys

Dated: August 16, 2005
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